

REMARKS/ARGUMENTS

The Office Action mailed October 8, 2003 has been carefully reviewed. Reconsideration of this application, as amended and in view of the enclosed Declarations and the following remarks, is respectfully requested. The claims presented for examination are: claims 1-35.

Claim Objections

In paragraphs 1 of the Office Action mailed October 8, 2003, claims 33-35 were objected to because of the informalities, "On line 3 of the claim 33, "exist" should be - - exit - -."

Claim 33 has been amended to change "exist" to - - exit - -. Applicant believes the informalities of claims 33-35 have been corrected.

35 USC 112 Rejection

In paragraphs 2-7 of the Office Action mailed October 8, 2003, claims 2, 16, and 18-24 were rejected under 35 U. S. C. 112, second paragraph, as being indefinite.

With regard to claims 2 and 20, it was stated, "The interferometer is a plurality of components and it is unclear how the interferometer as a whole can be construed as intersecting" Claims 2 and 20 have been amended to specify, "said interferometer has an arm and ... said interferometer arm orthogonally intersect ..." Applicant believes the indefiniteness of claims 2 and 20 has been corrected.

With regard to claim 16, it was stated, "it is unclear if the narrow line diode laser is the same thing as the 'at least one light source' of claim 1." Claim 16 has been amended to specify, "said interferometer includes a narrow line diode laser operating at 1310nm for monitoring." Applicant believes the indefiniteness of claim 16 has been corrected.

With regard to claim 18, it was stated, "It is entirely unclear how to interpret the limitation calling for an unspecified component of a white light interferometry system." Claim 18 has been amended to specify, "wherein said interferometer comprises a white light interferometry system." Applicant believes the indefiniteness of claim 18 has been corrected.

With regard to claim 19, it was stated, "the white light interferometry system" lacks antecedent basis. Claim 19 has been amended to depend from claim 18 which provides an antecedent basis. Applicant believes the indefiniteness of claim 19 has been corrected.

35 USC 103 Rejection

In paragraphs 8-19 of the Office Action mailed October 8, 2003 claims 1-12, 15-20, 24, and 30 were rejected under 35 U. S. C. 103(a) as allegedly being unpatentable over the primary reference, U.S. Patent No. 6,381,025 (Bornhop et al. Reference) in view of the secondary reference (Faubel et al.).

Enclosed are declarations by Anthony J. Ruggiero and Eddie E. Scott to overcome the primary Bornhop et al. Reference.

The primary Bornhop et al. Reference issued April 30, 2002 from an application filed March 6, 2000 and was based upon a provisional application filed on August 19, 1999; therefore, August 19, 1999 is the earliest effective date of the Bornhop et al. Reference.

The attached Declarations and the documents attached to the Declarations show that Applicant made the claimed invention before August 19, 1999 which is the earliest effective date of the Bornhop et al. Reference.

The documents attached to the Declarations (The Documents) have been maintained in the ordinary course of business of the University of California, the Lawrence Livermore National Laboratory, and the United States Department of Energy (DOE) and I am one of the custodians of The Documents. The Documents

have the dates blacked out as provided for in MPEP § 715.07 Facts and Documentary Evidence - ESTABLISHMENT OF DATES, provides, "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration." When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.

It is believed that the procedure of blacking out the dates is desirable to protect the Applicant's rights because the actual dates may become important in later proceedings and it would be detrimental to disclose exactly how early are Tony J. Ruggiero's dates.

The Declarations and The Documents show that The Inventor, Anthony J. Ruggiero, made the invention described and claimed in the subject patent application (hereinafter "The Invention") in this country prior to August 19, 1999; in particular the Declarations and The Documents show that Anthony J. Ruggiero conceived The Invention in this country prior to August 19, 1999; that Anthony J. Ruggiero made written descriptions of The Invention in this country prior to August 19, 1999; that Anthony J. Ruggiero disclosed The Invention to others in this country prior to August 19, 1999; and that Anthony J. Ruggiero reduced The Invention to practice in this country prior to August 19, 1999. Applicant submits that the foregoing is sufficient to establish that The Inventor, Anthony J. Ruggiero, made the invention described and claimed in the subject patent application (hereinafter "The Invention") in this country prior to August 19, 1999. Applicant submits that the Bornhop et al. Reference is not a valid reverence against the claims in the subject application.

As an alternative argument, it is Applicant's position that Applicant continuously worked on testing, developing, and patenting The Invention during the period from August 19, 1999 the earliest effective date of the Bornhop et al. reference until the subject application was filed (hereinafter "The Time Period"). Applicant has been diligent during the Time Period and Applicant submits that the Bornhop et al. Reference is not a valid reference against the claims in the subject application.

Since the primary Bornhop et al. Reference can not be used as a reference against the claims of the subject application, the combination of the primary Bornhop et al. Reference and the secondary Faubel et al. Reference can not be used to render the claimed invention unpatentable. Thus, the combination of references fails to support a rejection of the claims under 35 USC 103(a), and the rejection should be withdrawn and the claims now present in the application allowed.

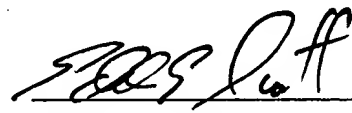
Allowable Subject Matter

In paragraphs 20-23 of the Office Action mailed October 8, 2003 allowable subject matter was identified as follows: claims 27-29 are allowed, claims 33-35 would be allowed if the objection to claim 33 were corrected, and claims 13, 14, 25, 26, 31, and 32 were objected to as being dependent on a rejected claim, but would be allowable if rewritten in independent form. Applicant appreciates the indication of allowable subject matter.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments, the enclosed Declarations, and the foregoing remarks, the rejections of the claims raised in the Office Action dated October 8, 2003 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eddie E. Scott", is written over a horizontal line.

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Dated: December 19, 2003